

## REMARKS

### **I. Introduction**

In response to the Office Action mailed June 6, 2006, Applicant has amended claim 1 so as to further clarify the claimed subject matter. New claims 19-23 are added. Support for the subject amendment can be found, for example, in Appendix A at pages 14-17, 38-39 and 45-52. No new matter has been entered.

For the reasons set forth below, Applicant respectfully submits that all pending claims are patentable over the cited prior art references.

### **II. The Rejection Of Claims 1 and 5 Under 35 U.S.C. § 102**

Claims 1 and 5 are rejected under 35 U.S.C. § 102(e) as being anticipated by USP No. 6,587,454 to Lamb. Applicant respectfully requests reconsideration of this rejection for at least the following reasons.

Claim 1, as amended, recites in-part a processor for use in a Voice-over-Internet Protocol telephone including a Voice-over-Internet Protocol processor core operable to transmit computer data and voice data over a computer network, the processor core including one or more pipelines.

In the statement of rejection, the Examiner reads the MAC/DSP circuits 73 of Lamb as corresponding to the claimed Voice-over-Internet Protocol processor core (see, page 2, item 2 of Office Action). Applicant respectfully disagrees. Specifically, the MAC/DSP circuits 73 of Lamb cannot properly be construed as a Voice-over-Internet Protocol processor core. In an effort to advance prosecution, Applicant has amended claim 1 to recite a Voice-over-Internet Protocol processor core that includes one or more pipelines. As Lamb is completely silent with respect to the MAC/DSP circuits 73 having any pipeline, Applicant respectfully submits that none of the features of Lamb which have been allegedly identified as a “processor core” can meet the limitations of amended claim 1.

Further, amended claim 1 recites an on-chip memory coupled to the Voice-over-Internet Protocol processor core through a bus, the on-chip memory including a program memory to include instruction and a data memory to store cache for the processor core.

Applicant notes that the Examiner has identified the downstream packet port 68 of Lamb as the claimed memory (see, page 3, lines 1-4 of Office Action). Applicant respectfully disagrees. Applicants have enclosed herewith the definition of a "port" as shown in Exhibit A (retrieved from Microsoft Computer Dictionary 5<sup>th</sup> Edition published By Microsoft Press) for the Examiner's convenience.

Particularly, a "port" is defined as an interface through which data is transferred between a computer and other devices. In the instant case, Applicant submits that the downstream packet port 68 of Lamb is connected to an external network interface card (or medium access controller) on a host computer (see, col. 5, lines 57-60), and serves as an interface through which data are transported between the network interface card and the node core logic 75. In contrast, a memory is a device where information can be stored and retrieved as shown in Exhibit B (also retrieved from Microsoft Computer Dictionary 5th Edition published By Microsoft Press). Lamb does not disclose that the downstream packet port 68 can be used to store or retrieve data, and therefore the downstream packet port 68 cannot correspond to a memory.

Nonetheless, in an effort to advance prosecution, Applicant has amended claim1 to recite a memory including a program memory to include instruction and a data memory to store cache for the processor core. Lamb fails to disclose or suggest these features, because the downstream packet port 68 of Lamb does not include a program memory or a data memory for including instruction or storing cache, respectively.

Even further, claim 1 recites a repeater, one or more communication ports and one or more IEEE 802.3 MACs each integrated onto a same chip as the Voice-over-Internet Protocol processor core.

The Examiner has stated that Lamb discloses this limitation because the alleged components are integrated onto the same adaptor 65. However, the Examiner is respectfully reminded that while the alleged components of Lamb may arguably be mounted onto a same adaptor, these alleged components are not necessarily mounted onto a same chip, as the adaptor may contain multiple chips and different components can be mounted on a different chip.

In this regard, the Examiner is also reminded that in order to rely upon the doctrine of inherency, the Examiner must present factual evidence to establish that the allegedly inherent feature is necessarily present in the prior art, in this case Lamb's adaptor, and that such would have been recognized by one having ordinary skill in the art. *Finnegan Corp. v. ITC*, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). In this respect, Applicants would again stress that inherency requires certainty, not mere possibilities. *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981).

As the Examiner has not explained how the alleged components of Lamb are necessarily mounted onto a same chip inside the adaptor 65, the Examiner has not fulfilled the requirement as defined in **M.P.E.P. 2112** under the section entitled "EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY", which sets forth the applicable standard:

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill'. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Accordingly, as anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), and at a minimum, Lamb fails to disclose or suggest the foregoing claim elements, Applicant respectfully submits that Lamb does not anticipate claim 1 or any of the claims dependent thereon.

### **III. The Rejection Of Claim 6 Under 35 U.S.C. § 103**

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Lamb in view of US Pub No. 20060072552 to Shnitzer. Applicant respectfully traverses this rejection for at least the following reasons.

Claim 6 recites in-part a flexible peripheral interconnect (FPI) bus. In the pending rejection, the Examiner again interprets the node core logic 75 of Lamb as corresponding to the foregoing claimed feature. However, the Examiner has neither provided any explanation as to why and how the node core logic 75 of Lamb functions in a manner similar to a FPI bus, nor a motivation for modifying Lamb to include such a FPI bus. Without any support or rationale presented in support of the Examiner's allegation that the node core logic 75 of Lamb corresponds to the claimed FPI bus, it is difficult for the Applicant to provide a proper rebuttal. In this regard, the Examiner is invited to review Appendix C of the specification titled "Flexible Peripherals Interconnect Bus Version 3.2" to learn what a FPI bus is. The Examiner is also invited to contact the undersigned attorney to further discuss this issue. Shnitzer does not cure this deficiency of Lamb, because Shnitzer does not disclose using any bus, let alone a FPI bus.

If the pending rejection is maintained, Applicant respectfully requests that the next Office Action provide explanation as to how the node core logic 75 of Lamb functions as a FPI bus so as to afford the Applicant an opportunity to address the Examiner's concern.

Thus, as each and every limitation must be either disclosed or suggested by the cited prior art in order to establish a *prima facie* case of obviousness (see, **M.P.E.P. § 2143.03**), and the combination of Lamb and Shnitzer fails to do so, Applicant respectfully submits that claim 6 is patentable over the cited prior art.

#### **IV. The Rejection Of Claim 10 Under 35 U.S.C. § 103**

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Lamb in view of Shnitzer, and further in view of USP No. 6,658,027 to Kramer. Applicant respectfully traverses this rejection for at least the following reasons.

Claim 10 recites in-part a flexible peripheral interconnect (FPI) bus. However, as discussed *supra*, neither Lamb nor Shnitzer teach this feature. Kramer does not cure this deficiency of Lamb. While Kramer discloses an address/data bus 325 that couples between the microprocessor 320, RAM 330 and ROM 340, and another address/data bus 375 that couples between the DSP 365, RAM 370 and ROM 380, Kramer neither teach that the address/data bus

325/375 is a FPI bus, nor provide any motivation for replacing the address/data bus 325/375 with a FPI bus.

Thus, for analogous reasons similar to those discussed with respect to claim 6, Applicant respectfully submits that the proposed combination of Lamb, Shnitzer and Kramer does not render claim 10 obvious.

**V. All Dependent Claims Are Allowable Because The Independent Claims From Which They Depend Are Allowable**

Under Federal Circuit guidelines, a dependent claim is neither anticipated nor rendered obvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplicatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as independent claims 1, 6 and 10 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

**VI. Conclusion**

By responding in the foregoing remarks only to particular positions taken by the Examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, Applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

For all of the reasons set forth above, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

Applicant : Frank Preiss  
Serial No. : 09/660,882  
Filed : September 13, 2000  
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120001 / 1999P07765US01

including extension of time fees, to Deposit Account 06-1050 and please credit any excess fees to such deposit account.

Respectfully submitted,

Date: October 6, 2006

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**pop** *vb.* To fetch the top (most recently added) element of a stack, removing that element from the stack in the process. *Compare* push<sup>2</sup> (definition 1).

**POP** *n.* See point of presence, Post Office Protocol.

**POP3** *n.* Acronym for Post Office Protocol 3. This is the current version of the Post Office Protocol standard in common use on TCP/IP networks. *See also* Post Office Protocol, TCP/IP.

**populate** *vb.* 1. To put chips in the sockets of a circuit board. 2. To import prepared data into a database from a file using a software procedure rather than by having a human operator enter individual records.

**pop-under ad** *n.* An advertisement on the Internet that appears in a new window in the background, behind the Web site content. Users may be unaware of the presence of pop-under ads until they close foreground windows at the end of a Web session. Pop-under ads may appear in response to a mouse click, a rollover, or after a user has spent a predetermined amount of time at a Web site. *See also* pop-up ad.

**pop-up ad** *n.* An advertisement on the Internet that appears in a new window in the foreground, often whenever a new page is opened within a site. Pop-up ads may appear in response to a mouse click, a rollover, or after a user has spent a predetermined amount of time at a Web site. *See also* pop-under ad.

**pop-up Help** *n.* An online help system whose messages appear as pop-up windows when the user clicks on a topic or area of the screen about which help is desired. Typically, a special form of click, such as clicking the right mouse button or Option-clicking, will activate pop-up Help, if it is available. *See also* Balloon Help.

**pop-up menu or popup menu** *n.* In a graphical user interface, a menu that appears on-screen when a user selects a certain item. Pop-up menus can appear anywhere on the screen and generally disappear when the user selects an item in the menu. *Also called:* popup, drop-down menu, pull-down menu.

**pop-up messages** *n.* The messages that appear when pop-up Help is used.

**pop-up window** *n.* A window that appears when an option is selected. Typically, the window remains visible until the mouse button is released.

**port**<sup>1</sup> *n.* 1. An interface through which data is transferred between a computer and other devices (such as a printer, mouse, keyboard, or monitor), a network, or a direct connection to another computer. The port appears to the CPU as one or more memory addresses that it can use to send or receive data. Specialized hardware, such as an add-on circuit board, places data from the device in the memory addresses and sends data from the memory addresses to the device. Ports may also be dedicated solely to input or to output. Ports typically accept a particular type of plug used for a specific purpose. For example, a serial data port, a keyboard, and a high-speed network port all use different connectors, so it's not possible to plug a cable into the wrong port. *Also called:* input/output port. 2. port number.

**port**<sup>2</sup> *vb.* 1. To change a program in order to be able to run it on a different computer. 2. To move documents, graphics, and other files from one computer to another.

**port 25 blocking** *n.* An anti-spam technique adopted by many ISPs to prevent bulk mailings of unsolicited commercial e-mail. Spammers may try to use SMTP servers to relay a single commercial e-mail to multiple recipients. Port 25 blocking filters prevent this spam distribution method. Although it is a popular remedy for some spam problems, port 25 blocking may cause problems for legitimate users of non-compatible e-mail programs.

**portable** *adj.* 1. Capable of running on more than one computer system or under more than one operating system. Highly portable software can be moved to other systems with little effort, moderately portable software can be moved only with substantial effort, and nonportable software can be moved only with effort similar to or greater than the effort of writing the original program. 2. Light enough, rugged enough, and free enough of encumbering external connections to be carried by a user.

**portable computer** *n.* Any computer designed to be moved easily. Portable computers can be characterized by size and weight. *See the table.*

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the virus also changes the registry, infects the Normal.dot Word template (which, in turn, infects new documents), and, in Office 2000, disables the Word macro virus warning. Although the Melissa virus does not destroy data, it can affect e-mail performance through the increased volume of messages. If an infected document is open at a time when the day of the month is the same as the minute value of the current time, the virus inserts the text "Twenty-two points, plus triple-word-score, plus fifty points for using all my letters. Game's over. I'm outta here" at the current location of the cursor. The virus was named after an acquaintance of the hacker who developed it.

**meltdown** *n.* 1. The complete collapse of a computer network caused by a higher level of traffic than the network can support. The term refers, by analogy, to the accidental melting down of a nuclear reactor core. 2. Colloquially, the breakdown of a person, usually in a job situation, caused by overwork, stress, or failure.

**member** *n.* 1. In object-oriented programming, a variable or routine that is part of a class. See also C++, class. 2. A value that is part of a set data structure. See also set<sup>2</sup> (definition 1).

**membrane keyboard** *n.* A keyboard in which an unbroken plastic or rubber shell (a membrane) covers keys that have little or no travel (movement). Rather than use normal, full-travel keys, membrane keyboards use pressure-sensitive areas that are sometimes, but not always, defined by small bumps under the membrane.

**memo field** *n.* A field in a database file that can contain unstructured text.

**memo pad** *n.* A note-taking feature offered by many personal digital assistants and other handheld computing devices. Memo pad allows for the entry of short notes via typing or handwriting recognition applications. The notes can be categorized, organized, and edited later.

**memory** *n.* A device where information can be stored and retrieved. In the most general sense, memory can refer to external storage such as disk drives or tape drives; in common usage, it refers only to a computer's main memory, the fast semiconductor storage (RAM) directly connected to the processor. See also core, EEPROM, EPROM, flash memory, PROM, RAM, ROM. Compare bubble memory, mass storage.

**memory bank** *n.* The physical location on a motherboard where a memory module can be inserted. See also bank (definition 1).

**memory board** *n.* A plug-in printed circuit board that contains one or more memory chips. See also memory chip.

**memory cache** *n.* See CPU cache.

**memory card** *n.* A memory module that is used to extend RAM storage capacity or in place of a hard disk in a portable computer, such as a laptop, notebook, or handheld PC. The module is usually the size of a credit card and can be plugged into a PCMCIA-compliant portable computer. The module can be composed of EPROM, RAM, or ROM chips or flash memory. Also called: RAM card, ROM card. See also EPROM, flash memory, handheld PC, hard disk, memory cartridge, module (definition 2), PCMCIA, RAM, ROM.

**memory cartridge** *n.* A plug-in module containing RAM (random access memory) chips that can be used to store data or programs. Memory cartridges are used primarily in portable computers as smaller, lighter (but more expensive) substitutes for disk drives. Memory cartridges typically use either a nonvolatile form of RAM, which does not lose its contents when power is turned off, or battery-backed RAM, which maintains its contents by drawing current from a rechargeable battery within the cartridge. Also called: RAM cartridge. See also memory card, RAM. Compare ROM cartridge.

**memory cell** *n.* An electronic circuit that stores one bit of data. See also bit.

**memory chip** *n.* An integrated circuit devoted to memory storage. The memory storage can be volatile and hold data temporarily, such as RAM, or nonvolatile and hold data permanently, such as ROM, EPROM, EEPROM, or PROM. See also EEPROM, EPROM, integrated circuit, memory board, nonvolatile memory, PROM, RAM, volatile memory.

**memory management** *n.* 1. In operating systems for personal computers, procedures for optimizing the use of RAM (random access memory). These procedures include selectively storing data, monitoring it carefully, and freeing memory when the data is no longer needed. Most current operating systems optimize RAM usage on their own; some older operating systems, such as early versions of MS-DOS, required the use of third-party utilities to optimize RAM usage and necessitated that the user be more

## EXHIBIT B